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EXAMINER

CANTELMO, GREGG

ART UNIT

PAPER NUMBER

1795

MAIL DATE

DELIVERY MODE

09/04/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Response to Amendment

1. In response to the amendment received May 6, 2009:
 - a. Claims 1-12 are pending;
 - b. Claims 1-9 and 11 have been withdrawn from consideration now as to non-elected inventions. Action on the merits of claims 10 and 12 follows with the prior art rejections of record maintained upon new claims 10 and 12.

Election/Restrictions

2. Applicant's election of Group I, claims 9-12 in the reply filed on July 22, 2009 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 1-8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 22, 2009.

Furthermore, claims 9 and 11 are withdrawn from consideration in light of the species election of M=Si. Claims 9 and 11 are drawn to M=Si and at least one element selected from the group recited in claim 9. Upon election of M=Si in the response filed July 22, 2009, those claims (claims 9 and 11) which do not read on this species are further withdrawn from consideration as to a non-elected invention.

Action on the merits of claims 10 and 12 follows.

Claim Rejections - 35 USC § 102

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3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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5. Claims 10 and 12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over KR 10-2002-0063681 (KR '681).

KR '681 discloses a solid electrolyte having the general formula including Li-P-O-Si-N (page 4, paragraph beginning with "The present invention ..."). Si is exemplary of M in the claimed product. The weight ration between the phosphorous and silicon in the sputtering target is proportioned relative to each other (page 8, first paragraph) and the sputtering composite target is then sputtered in the presence of nitrogen to form a thin film electrolyte containing Li-P-O-Si-N.

Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102 and 103, expressed as a 102/103 rejection.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)

In the case of the instant application the basis for expectation of inherency is that the prior art reference teaches of proportioning the ratio of P to Si (M) in the composite where the sum of the ratios of P to Si is one. The product, then sputtered in a reactive

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nitrogen gas will form a LiSiPON film having stoichiometric ratio of each element falling within the same claimed range, absent clear evidence to the contrary.

The Examiner invites applicant to provide that that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product.

Whether the rejection is based on inherency' under 35 U.S.C. 102, on prima facie obviousness' under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same...[footnote omitted]." The burden of proof is similar to that required with respect to product-by-process claims. In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977)).

Even if any differences are shown, such differences would be alternatively held to be minor and obvious, again absent clear evidence to the contrary.

Response to Arguments

6. Applicant's arguments filed May 6, 2009 have been fully considered but they are not persuasive.

Applicant argues that the amount of nitrogen in the claims is not the amount which necessarily flows from KR '681 because nitrogen is not included in the sputtering target.

This argument is not persuasive for the following reasons.

First, the argument that the reference may not necessarily teach the amount of Nitrogen is not persuasive in the absence of evidence to support Applicant assertion.

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Second, there is no requirement that nitrogen need be present in the sputtering target and one of ordinary skill in the sputtering art would have readily understood that the amount of nitrogen would have been incorporated due to the presence of a reactive sputtering environment wherein nitrogen, the reactive component, present in the plasma would have been an additional compositional component to the deposited film. This is further evident from the teaching of the composition of KR '681 which clearly teaches that nitrogen is, in fact, present in the deposited film and thus a requisite component of the composition.

Applicant argues that the claimed range "c" is critical but makes such assertion in the absence of any clear evidence and further fails to show that such a range is unobvious or provides unexpected results. In the absence of such, any such argument to the criticality for the range of "c" is not persuaded and further results in expected properties or results.

The Examiner maintains, in the absence of evidence to the contrary, that the conditions upon which the composition is sputtered in a nitrogen reactive plasma would have resulted in the same composition as that claims, else any differences between the two would have been minor and obvious. And while Applicant has argued to the contrary, the Examiner cannot be persuaded by such arguments since they fail to provide clear and convincing evidence to support their assertions/assumptions and it would still appear that the prior art conditions for sputtering would have anticipated, else obviated, the invention of claims 9 and 11.

For at least these reasons, Applicant arguments are not found to be persuasive and there is insufficient evidence to overcome the prior art rejection of record. Hence the rejection stands as applied to claims 9 and 11.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregg Cantelmo whose telephone number is 571-272-1283. The examiner can normally be reached on Monday to Thursday, 8:30-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gregg Cantelmo/
Primary Examiner, Art Unit 1795